

REMARKS

This responds to the Final Office Action mailed on July 9, 2008.

Claims 1-20, 26-31, 34-53, and 59-78 are amended, no claims are canceled, and no claims are added; as a result, claims 1-20, 26-31, 34-53, and 59-78 are now pending in this application.

§102 Rejection of the Claims

Claims 1-20, 26-31, 34-53 and 59-78 were rejected under 35 U.S.C. § 102(b) for anticipation by Auction Arms (hereinafter “Arms”). Applicants respectfully traverse these grounds for rejection.

The Final Office Action notes that the language of the independent claims is conditional on the occurrence of the events recited in the conditional statements. According to the Final Office Actions, the claims are not examined in their entirety because the methods as a whole are not satisfied unless the condition is satisfied.

The Final Office Action proceeds to examine the independent claims without giving patentable weight to the language after “when”. This, apparently, dictates the choice of prior art utilized by the Final Office Action. Applicants believe that there is neither law nor rule to support the contentions made by the Final Office Action with respect to conditional limitations and it has been standard USPTO practice to allow conditional limitations in claims. Nevertheless, the Applicants have amended the claims to present the claims without conditional statements.

To anticipate a claim, the reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987.)

It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed.

Cir. 1983)) (emphasis added). Applicants respectfully submit that the Final Office Action has not made out a *prima facie* case of anticipation by Arms.

Regarding independent claims 1, 26, 34, and 59:

Independent claims 26, 34, and 59 recite elements similar to the elements of independent claim 1. Accordingly, Applicants believe that patentability of independent claims 1, 26, 34, and 59 is best illustrated with regards to independent claim 1.

Independent claim 1 requires:

*a processor coupled to a memory through a bus; and
an auction price-setting process executed from the memory by the processor to determine that a high proxy bid is less than a reserve price and, in response, cause the processor to exchange of at least one of a proxy bid information of a buyer and a reserve price information of a seller, the at least one of the proxy bid information and the reserve price information being associated with a listing utilizing the auction price-setting process*

The Final Office Action points to the following text in Arms:

Auction Types at Auction Arms

Reserve Style Auction

We actually run a **Modified Reserve Style** auction. We differentiate from a traditional Reserve Style auction in that our proxy bidding doesn't kick in until after the Seller's reserve price has been met. All bids placed lower than the Seller's reserve price are in the open and visible for everyone to see. After the Seller's reserve has been met, proxy bidding kicks in and Max bids are kept hidden while proxy bids placed by the computer and bids beaten by a proxy bid are displayed.

In contrast to independent claim 1 Arms, page 7, "Reserve Style Auction" recites:

"We differentiate from a traditional Reserve Style auction in that our proxy bidding doesn't kick in until after the Seller's reserve price has been met."

Applicants respectfully disagree with the Final Office Action's contention that Arms anticipates independent claim 1 because Arms describes an auction system where proxy bidding starts only after the reserve price is met. In short, the auction system of Arms would never encounter a situation where a high proxy bid is less than the reserve price, as proxy bidding is

not enabled until the Seller's reserve price has been met. Accordingly, the determination as to whether or not to publish at least one of proxy bid for information or reserve price information, in the manner required by independent claim 1, is simply not made by the auction system described by Arms.

Because Arms does not describe every element of independent claim 1, either expressly or inherently, in a single prior art reference¹, Arms does not anticipate independent claim 1. Thus, Applicants respectfully request withdrawal of rejection of independent claims 1, 26, 34, and 59.

Regarding independent claim 8:

Independent Claim 8 requires:

*a processor coupled to a memory through a bus; and
an auction price-setting process executed from the memory by the processor to
determine that a high proxy bid is less than a reserve price and, in response,
cause the processor to exchange of at least one of a proxy bid information of a
buyer and a reserve price information of a seller, the at least one of the proxy bid
information and the reserve price information being associated with a listing
utilizing the auction price-setting process*

In contrast to independent claim 8, Arms in "Reserve Style Auctions" recites:

Auction Types at Auction Arms

Reserve Style Auction

We actually run a **Modified Reserve Style** auction. We differentiate from a traditional Reserve Style auction in that our proxy bidding doesn't kick in until after the Seller's reserve price has been met. All bids placed lower than the Seller's reserve price are in the open and visible for everyone to see. After the Seller's reserve has been met, proxy bidding kicks in and Max bids are kept hidden while proxy bids placed by the computer and bids beaten by a proxy bid are displayed.

Applicants respectfully submit that "Reserve Style Auction" does not disclose the limitations of independent claim 8 because "Reserves Style Auction" refers to "[a]ll bids placed lower than the Seller's reserve price" without respect to whether or not the current proxy bid is

¹ As required by Verdegaal Bros

greater than the reserve price. On the other hand, Claim 8 requires to *determine that a high proxy bid is less than a reserve price and, in response, cause the processor to exchange of at least one of a proxy bid information of a buyer and a reserve price information of a seller, the at least one of the proxy bid information*. Because Arms does not describe every element of independent claim 8, either expressly or inherently, in a single prior art reference², Arms does not anticipate independent claim 8. Thus, Applicants respectfully request withdrawal of rejection of independent claim 8.

Regarding claims 2-20, 27-31, 35-53, and 60-78:

Claims 2-20, 27-31, 35-53, and 60-78 are dependent of their respective independent claims 1, 26, 34, and 59, and include all of the limitations of their respective independent claims 1, 26, 34, and 59 from which they depend. For at least the reasons stated above with respect to independent claims 1, 26, 34, and 59, Arms fails to disclose the limitations of claims 2-20, 27-31, 35-53, and 60-78 and accordingly claims 2-20, 27-31, 35-53, and 60-78 are not anticipated by Arms. Because claims 2-20, 27-31, 35-53, and 60-78 are not anticipated by Arms, Applicants respectfully request reconsideration and withdrawal of the rejection, and allowance of claims 2-20, 27-31, 35-53, and 60-78.

Reservation of Rights

In the interest of clarity and brevity, Applicants may not have equally addressed every assertion made in the Final Office Action, however, this does not constitute any admission or acquiescence. Applicants reserve all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicants do not admit that any of the cited references or any other references of record are relevant to the present

² As required by Verdegaal Bros

claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicants timely object to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicants reserve all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 10/749,614

Filing Date: December 30, 2003

Title: METHOD AND SYSTEM TO PUBLISH A SELLER FIXED PRICE OFFER

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Dkt: 2043.033US2

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4051 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 9 day of September, 2008.

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